

REMARKS

Claims 1, 4, 7-11, 14-18, and 20 are now pending in the application. Claims 5-6, 12-13, and 19 have been cancelled in this paper. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

OBJECTIONS TO THE CLAIMS

Claims 1, 11, and 18 are objected to for failing to provide proper antecedent basis for "a POD interface" since the specification as filed discloses "a standard POD interface". Applicant has amended the application previously to specify that a POD is a portable device.

REJECTION UNDER 35 U.S.C. § 103

Claims 1 - 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,195,045 ("Keane") in view of U.S. Patent No. 6,131,125 ("Rostoker"). Claims 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,195,045 ("Keane") in view of U.S. Patent No. 6,601,115 ("Yonezawa"). Claims 2-3, 5-6, and 12-13, and 19 have been cancelled, thereby rendering their rejection moot.

Applicant has amended independent Claims 1, 11, and 18 to include a portable device including a coprocessor and a mass storage device selected from the group of CD-ROMs, FlashCards, Optical Disks, and magnetic media. These elements were originally recited in independent Claims 5-6, 12-13, and 19, which the examiner also

rejected under 35 U.S.C. § 103(a) as being unpatentable over Keane in view of Rostoker (Claims 5-6 and 12-13) or Keane in view of Yonezawa (Claim 19).

Applicant respectfully asserts that the amended claims are allowable since the combinations of Keane and Rostoker, and Keane and Yonezawa, do not establish prima facie obviousness.

Applicants respectfully submit that no motivation exists to combine Keane and Rostoker or to combine Keane and Yonezawa. Initially, Applicants direct the Examiner's attention to two recent cases decided by the Court of Appeals for the Federal Circuit (CAFC), In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed.Cir. 1999) and In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed.Cir. 2000). Both of these cases set forth very rigorous requirements for establishing a prima facie case of obviousness under 35 U.S.C. §103(a). To establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant. The motivation suggestion or teaching may come explicitly from one of the following:

- (a) the statements in the prior art (patents themselves),
- (b) the knowledge of one of ordinary skill art, or in some cases, and
- (c) the nature of the problem to be solved.

See Dembiczak 50 USPQ at 1614 (Fed.Cir. 1999). In Kotzab, the CAFC held that even though various elements of the claimed invention were present (in two separate embodiments of the same prior art reference), there was no motivation to

combine the elements from the separate embodiments, based on the teachings in the prior art.

In order to establish a prima facie case of obviousness under 35 U.S.C. §103(a), the Examiner must provide particular findings as to why the two pieces of prior art are combinable. See Dembiczak 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence".

In order to provide motivation for combining Keane and Rostoker, on pages 4-5 of the Final Office Action of February 16, 2005, the Examiner asserts:

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the smart communication device of Rostoker with the communication interface of Keane because it would provide for the purpose of providing communication between two or more digital electronic device (sic) with two of more communication protocols.

and with respect to showing motivation for combining Keane with Yonezawa, on page 7 of the Office Action, the Examiner asserts:

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the communication interface of Yonezawa with the communication interface of Keane because it would provide for the purpose handling (sic) a plurality of communication protocols without preparing an interface device for each communication protocol.

Applicant has read the entirety of Keane, Rostoker, and Yonezawa several times and do not see how reading these references one of ordinary skill in art would think to combine them. There is no teaching or suggestion in Keane to control the impedance matching apparatus with any protocol other than a first protocol that is native to the user interface. Also there is no teaching or suggestion to use the protocol translating device

of Rostoker between anything other than PCs and their common peripherals such as SCSI devices, printers, video, Firewire, etc. Similarly, there is no teaching or suggestion to use the protocol translating device of Yonezawa between anything other than a toolbox and an electronic control module, such as for controlling an internal combustion engine. Accordingly, Applicant respectfully submits that claims 1, 4, 7-11, and 14-18, and 20 are allowable for at least the reason that the Examiner has failed to establish proper prima facie cases of obviousness under 35 U.S.C. 103(a) in view of Dembiczak and Kotzab.

The Examiner is using impermissible hindsight reconstruction to reject the claims. The Examiner has used the present application as a blueprint, selected Keane's prior art impedance matching apparatus as the main structural device, and then searched other prior art for the missing elements without identifying or discussing any specific evidence of motivation to combine other than providing conclusory statements regarding the knowledge in the art, motivation and obviousness. The Federal Circuit has noted that the PTO and the courts "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention," In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988), and that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. Dembiczak, 50 USPQ2d at 1617.

The Examiner has not provided the requisite evidence to support his allegation that there is motivation to combine the Keane and Rostoker, and Keane and Yonezawa, references so as to render obvious that which Applicants have described. The essential factual evidence on the issue of obviousness is set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).

The Examiner has not provided the requisite showing of a suggestion, teaching, or motivation to combine the prior art references to reject claims 1, 4, 7-11, 14-18, and 20 in the present application. "The factual inquiry whether to combine references must be thorough and searching." Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'" (quoting C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 50 USPQ2d at 1617 ("Our case law makes clear that the best defense against the subtle but powerful

attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The Examiner's rejection has not been specific as to how each of the recited elements in claims 1, 4, 7-11, 14-18, and 20 are taught or suggested by his alleged combinations of Keane and Rostoker, and Keane and Yonezawa. Further, the Examiner has not adequately explained the reasons why one of ordinary skill in the art would have been motivated to select Keane and Rostoker, and Keane and Yonezawa, to reject claims 1, 4, 7-11, 14-18, and 20. The need for specificity pervades this authority. See, e.g., In re Kotzab, 55 USPQ2d at 1317 ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In

re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

Accordingly, the Examiner has not adequately supported the selection and combination of the Keane and Rostoker, and Keane and Yonezawa, references to render obvious that which Applicants have described. The Examiner's conclusory statement ". . . because it would provide for the purpose of providing communication between two or more digital electronic device (sic) with two of more communication protocols" does not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). The Examiner must explain the reasoning behind his findings of motivation. Simply stating that combining Keane and Rostoker, ". . . because it would provide for the purpose of providing communication between two or more digital electronic device (sic) with two of more communication protocols" or combining Keane and Yonezawa, ". . . because it would provide for the purpose handling (sic) a plurality of communication protocols without preparing an interface device for each communication protocol" are insufficient explanations for the alleged combinations.

Further, the Examiner is reminded that deferential judicial review under the Administrative Procedure Act does not relieve the agency (in this case the USPTO) of its obligation to develop an evidentiary basis for its findings. To the contrary, the Administrative Procedure Act reinforces this obligation. See, e.g., Motor Vehicle Manufacturers Ass'n v. State Farm Mutual Automobile Ins. Co., 463 U.S. 29, 43 (1983) ("the agency must examine the relevant data and articulate a satisfactory explanation for its action including a 'rational connection between the facts found and the choice made.'") (quoting Burlington Truck Lines v. United States, 371 U.S. 156, 168 (1962)). In this respect, since the examiner has not provided the requisite suggestion in the references to make his alleged combination, the Examiner rejects the precedent in In re Sung Lee, 23 USPQ2d 1780 (Fed. Cir. 2002).

In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action. See Motor Vehicle Manufacturers, 463 U.S. at 43 ("an agency rule would be arbitrary and capricious if the agency . . . entirely failed to consider an important aspect of the problem"); Mullins v. Department of Energy, 50 F.3d 990, 992 (Fed. Cir. 1995) ("It is well established that agencies have a duty to provide reviewing courts with a sufficient explanation for their decisions so that those decisions may be judged against the relevant statutory standards, and that failure to provide such an explanation is grounds for striking down the action."). As discussed in National Labor Relations Bd. v. Ashkenazy Property Mgt. Corp., 817 F.2d 74, 75 (9th Cir. 1987), an agency is "not free to refuse to follow circuit

precedent." Applicants submit that the Examiner has failed to provide a specific hint or suggestion in any of Wasko, Loucks or Kumar to support the alleged combination. In view of the foregoing, Applicants respectfully submit that the claims define over the art cited by the Examiner.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: May 16, 2005

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